

### **REMARKS**

The Action mailed on August 28, 2006<sup>5</sup> rejects claims 1-3, 5-15, 17, 18, 22, 23, and 32 under 35 USC § 103(a) as being unpatentable over US Patent 5,909,207 ("Ho"), in view of US Patent 6,525,749 ("Moran").

Applicant wishes to express his appreciation for the time and consideration provided by Examiner Lesperance during several telephonic interviews conducted between Examiner Lesperance and the undersigned since the issuance of the last office action. In particular, the undersigned and Examiner Lesperance discussed the then pending rejection of independent claim 1 under 35 U.S.C. § 103. No agreement was reached.

Before addressing the specific rejections set forth in the Action, Applicant points out that in making rejections under 35 U.S.C. § 103, the Examiner has yet again failed to provide any *evidence* as to why one skilled in the art would combine Ho and Moran. To make out a prima facie case of obviousness, an Examiner must provide evidence that one of ordinary skill in the art would be motivated to combine the references in question. As stated In Ex Parte Baldus, the Board of Patent Appeals and Interferences stated, "It is not sufficient to make up reasons for motivation, no matter how plausible these explanations may seem in hindsight, without some factual evidence to support those reasons." Appeal No. 97-0784, 1997 WL 1909601, \*3 (Bd.Pat.App & Interf.). The Action, however, only includes unsupported reasons for such a combination. It provides no evidence. Therefore, Applicant submits the rejection is improper.

Moreover, one of ordinary skill in the art would not have been motivated to combine Moran with Ho. Ho describes user interface devices and systems for browsing electronic documents such that the browsing mimics, to some degree, a paper book experience. For example, Ho describes page flip, page slide, and page fan animations used by the system to switch between pages of a document. To enable such animations, Ho describes converting electronic documents into a read-only format, such as .TIF or .AVI.

On the other Hand, Moran relates to a system for editing documents. In particular, Moran describes a system in which a stylus can be employed to rearrange digital content on a page to alter the structure of that digital content. This technology has no value in a browsing system in which the documents handled are read-only documents. Thus, one skilled in the art

would not have looked to Moran for modifications to Ho. Thus Applicant submits the proposed combination of Ho and Moran is improper.

Notwithstanding the above, to move prosecution forward, Applicant hereby cancels claims 1–3, 8–11, 14, 15, and 32 without prejudice or disclaimer and add new claims 33–52. Applicant also amends claims 5–7, 12, 13, 17, 18, and 22. No new matter is added.

The new claims include four independent claims, claims 33, 37, 50, and 53, which focus on four particular user interface commands described in the application. In particular, independent claim 33 recites a computing device capable of detecting and executing a page flip command via touch-sensitive display on which a page to be flipped is displayed. This subject matter is described at least at paragraph [0058] of the application. Independent claim 37 recites a computing device capable of detecting and executing a zoom command via a touch-sensitive display to zoom a document displayed on that touch-sensitive display. This subject matter is also described at least at paragraph [0058] of the application. Independent claim 50 recites a computing device capable of detecting and executing an inertial pan command. This subject matter is described at least at paragraph [0057] of the application. Lastly, independent claim 53 recites a computer device capable of detecting and executing a page curl command. This subject matter is described at least at paragraph [0058] of the application. Computing devices having one or more of such capabilities provide enhanced user experiences in viewing and navigating electronic documents.

Neither Ho nor Moran, individually or in combination, teach or suggest a computing device capable of detecting and executing such commands in such a fashion. Specifically, in relation to new independent claim 33, relating to a page flip command, Ho fails to describe, teach, or suggest a display monitor for detecting motion of a pointer across a touch-sensitive display on which an engine renders a first page of a document.

Ho describes various configurations of a trapezoidal-shaped browsing device. In addition to configurations in which slanted surfaces (forming the sides of the trapezoid) adjacent a primary display screen of a user interface device include force and position sensors for detecting navigational commands, Ho describes one configuration in which the slanted surfaces (i.e., the sides of trapezoid) of the browsing device are formed by separate displays that display

the relative amount of content in a document both before and after the content currently being viewed. Force and position sensors overlay the slanted displays. By moving one's thumb across the slanted displays, a user can cause the browsing device to navigate content. These touch-sensitive displays that can detect navigation commands, however, do not themselves display documents. The slanted displays only display representations of relative amounts of content. A touch-sensitive display that can both display pages of a document rendered by an engine and also detect a page-flip command via an interface process, however, is the explicit subject matter of new independent claim 33.

Moran fails to teach a page flip command, and thus could not possibly teach or suggest a touch-sensitive display that could both display a document and also be used to detect a page flip command. Moreover, as set forth above, one skilled in the art would not be motivated to combine Ho and Moran at least because the system set forth in Moran is specifically designed for editing documents and the devices in Ho are designed to operate with read-only documents. Thus, new independent claim 33 patentably distinguishes over the cited references. Claims 5–7, 12, 13, 17, 18, 22, 23, and 34–36 depend on claim 33 and add further limitations thereto. Thus, these claims also patentably distinguish over the cited references. Applicant therefore requests allowance of claims, 5–7, 12, 13, 17, 18, 22, 23, and 33–36.

Moreover, claims 22 and 23 recite additional patentably distinguishable subject matter. Specifically claim 22 recites that the interface process is also capable of detecting a user interface command for altering a transparency characteristic of a document displayed on the computing device. Ho and Moran are utterly silent with respect to a command for altering the transparency of a document. The action at page 10, as in previous actions, continues to assert that Moran teaches this subject matter based on a statement in Moran that the system described therein includes a transparent pressure sensitive type drawing surface. A surface is not a user interface command, as recited in the claim. Ho is silent with respect to transparency. Claim 23 depends on claim 22 and adds further limitations thereto. Thus, these claims distinguish over the cited references. Applicant therefore requests allowance of claims 22 and 23 on these additional grounds.

New independent claim 37 recites a computing device having a interface process capable of detecting a zoom command based on motion on a touch-sensitive display detected by a screen

monitor process. Neither Ho nor Moran describe teach or suggest a command to zoom a document. Thus, Applicant submits that claim 37 patentably distinguishes over the cited references. Claims 37-49 depend on claim 37 and add further limitations thereto. Therefore, Applicant requests allowance of claims 37-49.

With respect to new independent claim 50, Ho and Moran both fail to describe a computing device that can detect and execute a command that causes an engine to render a series of pages at a rate that is determined based on a detected velocity associated with a motion that triggered the command and based on a page inertia. Claims 51 and 52 depend on claim 50 and add further limitations thereto. Therefore, Applicant requests allowance of claims 50-52.

With respect to independent claim 53, both Ho and Moran fail to teach a computing device having a touch sensitive display that can be used to display a page of a document and also be used to enter a page curl command to curl a portion of the page. Therefore, Applicant requests allowance of claim 53.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response other than as reflected on the enclosed Amendment Transmittal. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. PGLD-P01-003 from which the undersigned is authorized to draw.

Dated: January 29, 2007

Respectfully submitted,

By   
Edward A. Gordon

Registration No.: 54,130  
ROPES & GRAY LLP  
One International Place  
Boston, Massachusetts 02110-2624  
(617) 951-7000  
(617) 951-7050 (Fax)  
Attorneys/Agents For Applicant